

**REMARKS**

The Examiner rejected Claims 1 and 5 under 35 U.S.C. § 112, second paragraph as containing subject matter which was not enabled by the specification. The Examiner rejected Claims 1 and 5 under 35 U.S.C. § 112, second paragraph as being indefinite. The Examiner rejected Claims 1, 2, 6, and 11-13 under 35 U.S.C. § 102(b) as being anticipated by Patent Number 5,589,672 ("Uchida"). The Examiner rejected Claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by Patent Number 4,612,426 ("Maier"). The Examiner rejected Claims 3, 4, 5, and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Uchida and in further view of Patent Number 5,645,329 ("Maddock"). Such rejections are noted.

Claims 1, 5, 6, and 11 have been amended. Applicant respectfully submits that Claims 1-13 are allowable.

**Rejection Under 35 U.S.C. § 112, second paragraph**

The Examiner rejected Claims 1 and 5 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and for not being enabled by the Specification.

Claims 1 and 5 have been amended to use terms consistent with those in the specification. In particular, the first and second opposing ledge elements have been renamed as second and fourth securing ledges. Each securing ledge further includes a surface as described in Paragraph 10 of the Specification. This clarification of the claim language makes clear that the word "opposing" in the original claim referred to a securing ledge adjacent to the first and second securing ledges and forming the opposite surface of the slots relative to the first and second securing ledges. Accordingly, Applicant respectfully submits that these amendments overcome the Examiner's section 112, second paragraph, rejections.

Additionally, Claims 1 and 5 have been amended to delete the limitations that the stop and locking members extend into the slot. This clarifying amendment was made to remove any ambiguity regarding the location of the stop and locking members

relative to the slots. The slots extend beyond the ends of the ledges because the arc plate slides into the slots. Accordingly, the stop and locking members extend into the open space that includes the portion of the slots that is beyond the end of the ledges.

### **Rejection Under 35 U.S.C. § 102(b)**

The Examiner rejected Claims 1, 2, 6, and 11-13 under 35 U.S.C. § 102(b) as being anticipated by Patent Number 5,589,672 ("Uchida"). The Examiner rejected Claims 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by Patent Number 4,612,426 ("Maier"). Applicant respectfully suggests that neither Uchida nor Maier anticipate the claims of the present invention. Section 2131 of the Manual of Patent Examining Procedure describes the basis for anticipation under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

### **The Uchida Patent**

Uchida discloses several embodiments of a circuit breaker with an arc quenching device. Uchida discloses an insulator **14** having a plurality of slots **15** into which arc plates (grids **2**) fit. Uchida, Fig. 2; Col. 6, lines 10-20. In the first embodiment, the grids **2** disclosed by Uchida are thicker than the slots **15** into which they fit, thereby securing the grids **2** in the slots **15** by pushing each grid **2** into a slot **15**. Uchida, Col. 6, lines 28-32. In a second embodiment, the arms **2a** of the grids **2** have nails **2C**, which bite into the bottom of the slots **15**, thereby securing the grids **2** in the slots **15**. Uchida, Col. 7, lines 33-44.

In another embodiment, a protection board **21** is fixed in the insulator **14**. Uchida, Figs. 8A, 8B, 9A, 9B; Col. 8, lines 14-16. The protection board **21** has a

plurality of pressing projections **21g** that extend from the surface **21a** of the protection board **21** and press against the grids **2** inserted into the insulator **14**. Uchida, Col. 8, lines 39-44 & 57-65. The protection board **21** also includes hooks **21f** adapted to fit engaging steps **14f** formed in the insulator **14**. Uchida, Col. 8, lines 45-50. The protection board **21** is secured to the insulator **14** with the hooks **21f** and attaching feet **21d**. Uchida, Col. 8, lines 50-54. The pressing projections **21g** function by providing pressure to the grids **2** after the grids **2** are inserted and after attaching the protection board **21** to the insulator **14**. Uchida, Col. 8, lines 57-65. By its inherent nature, the projection board **21** must be a component discreet from the insulator **14** and cannot be integrally formed with the insulator **14** such that the protection board **21** and the insulator **14** are one piece.

In still another embodiment, the grids **2** are secured by an insulation partition **22**, which has tongue-shaped pressing pieces **22c** for pressing the grids **2**. Uchida, Col. 9, lines 11-16, 30-33, Figs. 10-14. The tips of the pressing pieces **22c** have pressing projections **22f** that press against the end of the grids **2**, thereby fixing the grids **2** in the insulator **14**. Uchida, Col. 9, lines 37-42, 59-61. The insulation partition **22** is attached to the insulator **14** by engaging hooks **22e** on the insulation partition **22** with slits **14h** in the insulator **14** and by engaging projections **22d** on the insulation partition **22** with corresponding holes in the insulator **14**. Uchida, Col. 9, lines 43-61, Figs. 11 & 14. The insulation partition **22** functions to secure the grids **2** by applying pressure to the only remaining unrestrained side of the grid **2**. By its inherent nature, the insulation partition **22** must be a component discreet from the insulator **14** and cannot be integrally formed with the insulator **14** such that the insulation partition **22** and the insulator **14** are one piece.

#### **Claims 1 and 2**

With respect to Claims 1 and 2, the Examiner states that Uchida discloses "the stop member engaging the first end of the arc plate; and a locking member (**21g**) (Figs.8B and 9B) extending into the first and second slots engaging the second end of the arc plates." With respect to Claim 2, the Examiner states that Uchida " further disclose resilient stop members (**21c**) (Figs. 12A-12D) with tabs (**21f**) extending into

the first and second slots engaging the first end of the arc plates, fixing them in place." Paper No. 4, Application Serial Number 10/003,370, para. 6.

With respect to Claim 1, the Examiner states that Uchida discloses "the stop member engaging the first end of the arc plate; and a locking member (**21g**) (Figs. 8B and 9B) extending into the first and second slots engaging the second end of the arc plates." *Id.* With respect to Claim 2, the Examiner states that Uchida discloses "resilient stop members (**21c**) (Figs. 12A-12D) with tabs (**21f**) extending into the first and second slots engaging the first end of the arc plates, fixing them in place." *Id.*

Claim 1 has been amended to add the limitation that said stop member is "resilient." In his rejection, the Examiner does not identify the structure disclosed in Uchida that anticipates the stop member. However, the structures corresponding to the stop members include the inside back surface of the slots **15** formed integrally within the insulator **14**, and this structure is not disclosed as resilient. See Figs. 7(B), 9(B), 10, and 14. Accordingly, Claim 1 includes at least one limitation not found in Uchida, and Applicants respectfully submit that Claim 1 is not anticipated by Uchida and is in condition for allowance.

With respect to Claim 2, initially, Applicant notes that items **21c** and **21f** do not appear on Figures 12A-12D, but on Figure 8(B). Further, the insulation partition **22** shown on Figures 12A-12D is not used at the same time as the protection board **21** shown in Figures 8(A), 8(B), 9(A), and 9(B), but is disclosed as an alternative embodiment by Uchida. Also, Applicant points out that the claimed stop member and the claimed locking member engage opposite ends of the arc plate, which cannot be accomplished with the protection board **21** disclosed by Uchida as asserted by the Examiner.

Finally, the Examiner asserts that Uchida discloses a resilient stop member (**21c**); however, Figures 8(B) and 9(B) of Uchida do not show the member **21c** engaging the first end of the arc plate, which is opposite the second end where the locking member is located, as required by the limitation in the base claim. Accordingly, Claim 2, and its base claim, include at least one limitation not found in Uchida, and

Applicants respectfully submit that Claim 2 is not anticipated by Uchida and is in condition for allowance.

**Claim 6**

With respect to Claim 6, the Examiner states that Uchida discloses a locking member (**21g**) secured in spaced relation to the first wall. Paper No. 4, Application Serial Number 10/003,370, para. 7. The Examiner states that Uchida discloses "a back stop member (C) secured in spaced relation to the first wall."

Claim 6 has been amended to include the limitation that the back stop member is "resilient." The back stop disclosed in Uchida is a rigid assembly formed in the insulator **14**. Uchida, Fig. 7(B). Accordingly, Applicants respectfully submit that Claim 6 is not anticipated by Uchida and is in condition for allowance.

**Claim 11**

With respect to Claim 11, the Examiner states that the Uchida discloses "a back stop (C) positioned at the back end; locking member (**21g, 22c**) secured in spaced relation to the first wall." Paper No. 4, Application Serial Number 10/003,370, para. 8.

Claim 11 has been amended to add the limitation that the back stop is resilient. The claim has also be amended to show the relationship between the resilient back stop and the locking member. The resilient backstop, in combination with the locking member, secures the arc plate in the slot by forcing the arc plate against the locking member. See Applicant's Specification, para. 12. Uchida does not disclose a back stop that is resilient. Accordingly, Applicant respectfully submits that the rejection of Claim 11 has been overcome.

The Examiner has cited Madock as a reference supporting rejections under section 103. Although, Madock discloses a resilient stop member, Madock is not a proper prior art reference to support a prima facie case of obviousness. As discussed below, the first element of a prima face case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or

combine reference teachings." MPEP § 2143. Madock discloses a holder for compact discs, which are a consumer item falling within United States Classification 312/9.63, which relates to cabinet structures, specifically, those for storing audio or visual recording medium with a rotating closure type. The subject matter of the present invention relates to an internal component of an electrical circuit breaker, which is an industrial component. Persons of ordinary skill in the art of electrical circuit breakers would not necessarily be familiar with the art of consumer audio/visual cabinets. Without motivation to combine the teachings of Madock with Uchida, no prima facie case of obviousness can stand.

### **Claims 12 and 13 (Anticipation by Uchida)**

Claims 12 and 13 include means-plus-function limitations, as defined by 35 U.S.C. § 112, sixth paragraph. A means-plus-function limitation must be interpreted to cover the corresponding structure, materials, or acts in the specification and "equivalents thereof." See 35 U.S.C. § 112, sixth paragraph; see also *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424, 43 U.S.P.Q.2d 1896, 1899 (Fed. Cir. 1997); MPEP § 2181. Accordingly, it is necessary to consider the Specification in determining the scope of the rejected claims. In other words, the structure disclosed in the specification corresponding to the means-plus-function limitation must be found in the reference for the limitation to be anticipated. It is not enough to find just the function in the reference.

The Examiner states that Uchida discloses "a means (**2c**) for securing the arc plate in the arc housing." Paper No. 4, Application Serial Number 10/003,370, para. 9.

Claim 12 includes the limitation "a means for securing said arc plate in said arc stack housing." The Specification describes "members for securing a plurality of arc plates **402** in the housing **102**," and these members include the securing ledges **210** that define the slots **216**, the stop member **218**, and the locking arm **224** with a locking tab **222**. Applicants' Specification, para. 10-11. Although Uchida discloses slots **15**, Uchida does not disclose any structure corresponding to the stop member **218**, and the locking arm **224** with a locking tab **222**. The rear stop **218** and the

locking arm **224** with a locking tab **222** are substantially different than the pressing pieces **22c** with the pressing projections **22f** disclosed in Uchida.

Claim 13 includes the limitation "a means for preventing said arc plate from vibrating in said arc stack housing." Applicant's Specification states that "the spring action of the locking arm **224** and the spring action of the rear stop **218** serve to capture and prevent the arc plate **402** from vibrating in the housing **102**." Applicants' Specification, para. 14. Accordingly, the structure corresponding to this means limitation includes the locking arm **224** and the rear stop **218**. Further, the Specification describes the configuration of these components relative to the housing **102**. See Applicant's Specification, para. 9-14. Applicants respectfully submit that Claim 13 is not anticipated by Uchida because the pressing pieces **22c** of Uchida are substantially different than the locking arm **224** and the rear stop **218** disclosed by Applicant. In particular, the pressing pieces **22c** of Uchida are not integral to the housing (insulator **14**) such that securing the arc plates (grids **2**) requires only insertion of the arc plates (grids **2**), instead, Uchida requires the addition of an additional piece (insulation partition **22**) after insertion of the arc plates (grids **2**) in order to secure the arc plates (grids **2**).

Applicants respectfully submit that Claims 12 and 13 include elements not disclosed by Uchida, and, therefore, Uchida does not teach every element of the claimed invention. Accordingly, Applicants respectfully suggest that Uchida does not anticipate Claims 12 and 13.

#### **Claims 12 and 13 (Anticipation by Maier)**

As stated above, Claims 12 and 13 include means-plus-function limitations, as defined by 35 U.S.C. § 112, sixth paragraph. The Examiner states that Maier includes means (**49**, **51**) for securing the arc plates in the housing. Paper No. 4, Application Serial Number 10/003,370, para. 10 (citing Maier, Col. 2, lines 9-16).

Maier discloses an arc chute assembly **22** including a plurality of arc chute plates **44** retained in a stacked and spaced relationship between to side panels **48**. Maier, Col. 4, lines 54-55; Fig. 3. Each arc chute plate **44** has laterally protruding prongs, such as T-shaped tabs **49** that project through a plurality of laterally

extending slot openings **51** in the side panels. Maier, Col. 4, lines 55-58. The arc chute plates **44** are secured by wedging a pair of key members **52** between the side panels **51** and the arc chute plates **44**. Maier, Col. 4, lines 58-63. The arc chute plates **44** of Maier perform a similar arc-quenching function as the arc plates of the present invention; however, the arc chute plates **44**, and their structural attachment to the side panels **51**, are substantially different than the structure disclosed by Applicant for securing the arc plates in the housing and for preventing the arc plates from vibrating. Accordingly, Applicants respectfully submit that Claims 12 and 13 include elements not disclosed by Maier, and, therefore, Maier does not teach every element of the claimed invention. Accordingly, Applicants respectfully suggest that Maier does not anticipate Claims 12 and 13. Having no further rejection of or objection to Claims 12 and 13, it is respectfully submitted that Claims 12 and 13 are in condition for allowance.

### **Obviousness Under 35 U.S.C. § 103**

The Examiner rejected Claims 3, 4, 5, and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Uchida and in further view of Patent Number 5,645,329 ("Madock"). A rejection under 35 U.S.C. § 103(a) must be supported by a prima facie case of obviousness. MPEP § 2142. The first element in establishing a prima facie case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." MPEP § 2143. The second element is that there must be a reasonable expectation of success. *Id.* The third element is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *Id.* "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper); see MPEP § 2143.01.



The relevant facts for finding obviousness relate to (1) the scope and content of the prior art, (2) the level of ordinary skill in the field of the invention, (3) the differences between the claimed invention and the prior art, and (4) any objective evidence of nonobviousness such as long felt need, commercial success, the failure of others, or copying. *Graham v. John Deere Co.*, 148 U.S.P.Q. 459, 467 (U.S. 1966). The obviousness analysis articulated by the United States Supreme Court in *Graham* requires that “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Id.* With respect to the fourth factor, the Supreme Court allowed that “[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Id.*

Madock discloses a compact disc case holder **10** having a bottom wall **12**, side walls **13**, **14**, and a top wall **16**. Madock, Col. 2, lines 41-43. The compact disc case holder **10** has a plurality of compact disc case holding areas **80** defined by ribs **82-90**, **92-100** that project inward from the bottom and top walls **12**, **16**. Madock, Col. 3, lines 1-17. The back end of the holding area **80** has an S-curve spring **104** and a retaining member **106**. Madock, Col. 3, lines 18-20. The retaining member **106** includes a movable or deflectable cantilevered portion **108** formed in the bottom wall **12**. Madock, Col. 3, lines 20-23. At the end of the cantilevered portion **108** is an actuator portion **114** with an upstanding lip **116**, which engages a side of a compact disc case **102**. Madock, Col. 3, lines 23-26; Figs. 2A & 2B.

Applicant respectfully submits that Madock is not a proper reference to support the Examiner's obviousness rejections. Initially, the first element of a prima facie case of obviousness is that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.” MPEP § 2143.

First, Madock does not provide any suggestion or motivation to modify the device of Uchida or to combine the two references. Madock discloses a compact disc holder, which is an art that is unrelated to electrical circuit breakers and arc

quenching devices. Second, the knowledge generally available to one of ordinary skill in the art is not such to suggest or motivate one of ordinary skill in the art to modify Uchida or combine the references. Madock discloses a holder for compact discs, which are a consumer item falling within United States Classification 312/9.63, which relates to cabinet structures, specifically, those for storing audio or visual recording medium with a rotating closure type. The subject matter of the present invention relates to high voltage switches with arc preventing or extinguishing devices as in Classification 218/34. Persons of ordinary skill in the art of high voltage switches would not necessarily be familiar with the art of consumer audio/visual cabinets. Accordingly, the first element of a prima facie case of obviousness has not been shown by the Examiner because, first, the references do not contain a suggestion or motivation to combine or modify and, second, the knowledge of one of ordinary skill in the art would not suggest or motivate to combine or modify the references.

Further, the problem being solved by Madock is different than the problem being solved by Applicant. As stated in MPEP § 2141.02, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02 (emphasis in original) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)). Pertinent to the analysis of the invention as a whole is identification of the problem being solved. See MPEP § 2141.02.

Madock describes the problems of the prior art, which includes the difficulty in removing a compact disc from a holder. Madock, Col. 1, lines 11-22. Madock solves this problem by providing a mechanism for manually ejecting a compact disc from a holder. Madock, Col. 1, lines 28-30. The mechanism of Madock includes an S-curve spring **104** that ejects the compact disc case **102** from the holder **10**. Madock, Col. 3, lines 44-52. The function of the S-curve spring **104** is to eject, or push, the case **102** out of the holder **10**. One problem solved by the present invention is capturing and preventing the arc plate **402** from vibrating in the housing **102**, which is the function of the rear stop **218** and the locking arm **224**. Applicant's Specification, para. 14.

The problem solved by Madock of how to easily remove a compact disc is diametrically opposed to the problem solved by Applicant of how to capture and secure an arc plate in an arc quencher. Applicant respectfully submits that motivation is not indicated because the prior art reference solves a substantially different problem than that solved by the present invention.

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Finally, the Examiner, in the obviousness rejections further detailed below, states that combining Madock with Uchida allows for the "partial ejection of the arc plate from the housing so that it may be easily grasped by a user." Applicant points out that the partial ejection of the arc plate from the housing is not a stated objective of Applicant's invention. Once the arc plate is secured in the housing, the arc plate is not removed from the housing for the arc stack to perform its intended function. The intended function of the arc stack is substantially different than that of the compact disc case holder disclosed in Madock, which requires the compact disc cases to be easily removed from the holder.

Accordingly, the Applicants respectfully submit that because Madock does not address the problem solved by the Applicant, Madock is not an appropriate reference for an obviousness rejection and the Examiner has not shown that it would have been obvious to one of ordinary skill in the art of high voltage switches to apply a solution from the art of audio/visual medium cabinet structures.

#### **Claims 3 and 4**

With respect to Claims 3 and 4, the Examiner states that the claims are unpatentable over Uchida as applied to Claim 1 and in further view of Madock. Paper No. 4, Application Serial Number 10/003,370, para. 12.

The Examiner, with respect to Claims 3 and 4, asserts:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the integrally molded supports with all the elements taught by Madock, modifying the integrally molded housing, the stop members, the locking members and securing ledges, disclosed by Uchida et al., thus forming an integrally molded assembly consisting of support members, securing ledges, stop members and locking members,

thereby substantially reducing the cost of manufacturing for the housing, as well allowing for the partial ejection of the arc plate from the housing so that it may be easily grasped by a user.

Paper No. 4, Application Serial Number 10/003,370, para. 12. Section 2144.03 of the Manual of Patent Examining Procedure states:

The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside the records which are capable of instant and unquestionable demonstration as being "well-known" in the art.

MPEP § 2144.03. Applicants request the Examiner provide evidence to support his assertion of obviousness as it is respectfully submitted that the cited reference does not support such a conclusion as described previously in the discussion of Madock. See MPEP 2144.03, pg. 2100-129, 8th ed.

Initially, Applicant points out that the partial ejection of the arc plate from the housing is not a stated objective of Applicant's invention. Once the arc plate is secured in the housing, the arc plate is not removed from the housing for the arc stack to perform its intended function. The intended function of the arc stack is substantially different than that of the compact disc case holder disclosed in Madock, which requires the compact disc cases to be removed from the holder.

Further, Applicants respectfully submit that Madock is not a proper reference for an obviousness rejection for the reasons provided previously in the discussion of Madock. Accordingly, Applicant respectfully submit that Claims 3 and 4 are in condition for allowance because a prima facie case of obviousness has not been shown by the Examiner.

#### **Claim 5**

With respect to Claim 5, the Examiner states that the claim is unpatentable over Uchida and Madock. Paper No. 4, Application Serial Number 10/003,370, para. 13.

With respect to Claims 3 and 4, the Examiner asserts:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the integrally molded supports with all the elements taught by Madock, modifying the housing, the stop members, the locking members and securing ledges, disclosed by Uchida et al., thus forming an integrally molded assembly consisting of support members, securing ledges, stop members and locking members, . . .

Paper No. 4, Application Serial Number 10/003,370, para. 13. Applicants request the Examiner provide evidence to support his assertion of obviousness as it is respectfully submitted that the cited reference does not support such a conclusion as described previously in the discussion of Madock. See MPEP 2144.03, pg. 2100-129, 8th ed.

Claim 5 has been amended, as described previously, to address the Examiner's section 112, second paragraph, rejection. Applicants respectfully submit that Madock is not a proper reference for an obviousness rejection for the reasons provided previously in the discussion of Madock. Accordingly, Applicant respectfully submit that Claim 5 is in condition for allowance because a prima facie case of obviousness has not been shown by the Examiner.

#### **Claim 7 and 8**

With respect to Claims 7 and 8, the Examiner states that the claims are unpatentable over Uchida as applied to Claim 6 and in further view of Madock. Paper No. 4, Application Serial Number 10/003,370, para. 14.

With respect to Claims 7 and 8, the Examiner asserts:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the integrally molded wall with all the elements taught by Madock, modifying the apparatus for quenching an arc, the walls, the back stop members, the locking members and securing ledges, disclosed by Uchida et al., thus forming an integrally molded assembly consisting of support members, securing ledges, back stop members and locking members, . . .

Paper No. 4, Application Serial Number 10/003,370, para. 14. Applicants request the Examiner provide evidence to support his assertion of obviousness as it is respectfully

submitted that the cited reference does not support such a conclusion as described previously in the discussion of Madock. See MPEP 2144.03, pg. 2100-129, 8th ed.

Applicants respectfully submit that Madock is not a proper reference for an obviousness rejection for the reasons provided previously in the discussion of Madock. Accordingly, Applicant respectfully submit that Claim 5 is in condition for allowance because a prima facie case of obviousness has not been shown by the Examiner.

### **Claims 9 and 10**

With respect to Claims 9 and 10, the Examiner states that the claims are unpatentable over Uchida and Madock. Paper No. 4, Application Serial Number 10/003,370, para. 15.

With respect to Claims 9 and 10, the Examiner asserts:

Uchida et al. disclose an integrally molded apparatus for quenching an arc (**14**) (Figs. 1-12) having a first wall (**14a**); a second wall (**14a**) secured in spaced relation to the first wall; a first slot (**S1**) formed in the first wall and opening toward the second wall; a second slot (**S2**) formed in the second wall and opening toward the first wall; an arc plate (**2**) in slidable communication with the first slot and the second slot; a back stop member (**C**) secured in spaced relation to the first and second wall and extending into each of the first and second slots, the back stop member engaging the arc plate; and a locking member (**21g**) (Figs. 8B and 9B) secured in spaced relation to the first and second wall and extending into the first and second slots engaging the second end of the arc plates, and resilient and deformable locking members (**21c**) (Figs. 12A-12D) with tabs (**21f**) extending into the first and second slots engaging the arc plates, securing them in place against the back stop members. Uchida et al. do not expressly disclose an integrally molded apparatus for quenching an arc wherein the resilient member of the locking member further having a first end fixedly attached to the first securing ledge and having a second end connected to the tab, the tab having an inside face for contact with an arc plate; wherein the back stop member is resilient and deformable, the back stop member being deformed and in contact with the arc plate, whereby the back stop member pushes the arc plate towards the tab. Madock teaches an apparatus (Figs. 1-7) capable of securing an arc plate having an integrally molded wall (**12**) having locking members (**106**) including a resilient member (**108**) and a tab (**114**), the resilient member having a first end fixedly attached to a first securing ledge

(82-90) and having a second end connected to the tab, the tab having an inside face (116) in contact with an arc plate; back stop members (104) that are resilient and deformable; the back stop member being deformed and in contact with an arc plate, whereby the back stop members push an arc plate towards the tab. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the integrally molded wall with all of the elements taught by Madock, modifying the integrally molded apparatus for quenching an arc, the walls, the stop members, the locking members and securing ledges, disclosed by Uchida et al., thus forming an integrally molded assembly consisting of walls, securing ledges, stop members and locking members, thereby substantially reducing the cost of manufacturing of the apparatus (Madock: col. 4, lines 31-34), as well allowing for the partial ejection of the arc plate from the housing so that it may be easily grasped by a user (Madock: col. 1, lines 39-42).

In further regards to claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the apparatus and all of the elements disclosed by Uchida et al. and Madock, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 US. 164 (1893).

Paper No. 4, Application Serial Number 10/003,370, para. 15. (emphasis added). Applicants request the Examiner provide evidence to support his assertion of obviousness as it is respectfully submitted that the cited reference does not support such a conclusion as described previously in the discussion of Madock. See MPEP 2144.03, pg. 2100-129, 8th ed.

As affirmed by the Examiner's comments, Uchida does not disclose either a locking member or a back stop member as claimed in Claim 9. Neither is there motivation or a suggestion to combine the teachings of Madock with Uchida. Applicants respectfully submit that Madock is not a proper reference for an obviousness rejection for the reasons provided previously in the discussion of Madock. Accordingly, Applicant respectfully submit that Claim 9, and dependent Claim 10, are in condition for allowance because a prima facie case of obviousness has not been shown by the Examiner.

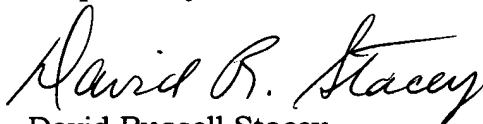
Notwithstanding Claim 10 being deemed allowable by depending from an allowable base claim, Applicants respectfully submit that Claim 10 is allowable because the holding of *Howard v. Detroit Stove Works* is not applicable to the configuration of the elements in Claim 10. *Howard* states that "it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together." The claim in *Howard* was found to be anticipated by a pre-existing product having all the elements of the claim except for one piece being cast in two pieces. *Howard*. However, in Applicants' invention, the Examiner has not shown anticipation in which all the elements are found in the prior art except for the claimed elements forming an integral assembly. Rather, the Examiner has pulled a collection of elements from two references, without any suggestion or motivation to combine, and asserts that it would be obvious to further have these elements be integrally formed into an assembly. Because the holding of *Howard* is not applicable, Applicants request the Examiner provide evidence to support his assertion of obviousness as it is respectfully submitted that the cited reference does not support such a conclusion. See MPEP 2144.03, pg. 2100-129, 8th ed.

### Conclusion

In view of the amendment of Claims 1, 5, 6, and 11 and the arguments provided above, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the Examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 19-3875 (LEX-80).

Respectfully submitted,

  
David Russell Stacey  
Registration No. 33,794



Square D Company  
1415 S. Roselle Road  
Palatine, Illinois 60067  
(847) 925-3458 Voice  
(847) 925-7419 Fax